

REMARKS

Claims 1, 10, and 13 have been amended. Claims 4, 16 and 20 have been written in independent form. Claims 17-19 have been canceled. Claims 1-16 and 20 are pending.

Claims 1, 2, 3 and 9 are Patentable Over the I.610 Reference

Claims 1, 2, 3 and 9 were rejected as anticipated by the ITU-T Recommendation I.610, B-ISDN Operation and Maintenance Principles and Functions (I.610 reference).

Claim 1 has been amended to recite, "the pattern of bits is generated by a narrowband-to-packet network adapter having a bit pattern generator." The I.610 reference discloses continuity checking over a broadband (packet) network by a loop back of a check cell (par. 6.2.1.1.2, page 15).

In contrast, the present application claims a narrowband-to-packet network adapter. Also, the adapter includes a bit pattern generator. See specification page 6, lines 19-21. The adapter includes the bit pattern generator shown in FIG. 2 and described in the specification at page 8, lines 3-10.

Thus, claim 1 is not anticipated by the I.610 reference because the reference does not disclose each and every element recited in the claim. That is, the references do not disclose that a narrowband-to packet network adapter includes a bit pattern generator.

The Applicants respectfully request withdrawal of the 35 U.S.C. 102 rejection of claim 1. Claims 2-9 depend from claim 1 and should be allowable for at least the same reasons.

Claims 4, 5, 16 and 20 are Patentable Over the Cited References

In the Office action, the claims 4, 5, 16 and 20 were rejected as follows:

(1) Claims 4-5 were rejected as unpatentable over ITU-T Recommendation I.610 in view of Committee T1S1 Contribution on Q.SCOBB ("Q.SCOBB").

(2) Claims 16 and 20 were rejected as unpatentable over the Q.SCOBB reference in view of the Nakayama patent.

Claims 4, 16 and 20 have been written in independent form including the features of the unamended claims 1, 13 and 17.

The pending application claims the benefit of priority of U.S. Provisional Application Ser. No. 60/147,462, filed August 6, 1999. The subject matter of the pending claims is entitled to that priority date.

The effective date of the Q.SCOBB reference, which the Office Action cites for its disclosure of techniques for supporting narrowband services via broadband bearer technologies, is its publication date of June 20, 1999.

The following Exhibits are submitted in support of this Reply and establish that the rejection of claims 4, 5, 16 and 20 should be withdrawn based on applicant's swearing back of the Q.SCOBB reference:

Exhibit A – Declaration of Dale Scholtens under 37 C.F.R. 1.131; and

Exhibit B – Declaration of Paul A. Levy.

Exhibit A is a declaration by one of the inventors, Dale Scholtens, demonstrating conception of the claimed subject matter prior to the effective date of the Q.SCOBB reference. The declaration refers to claims before any amendments made in this reply.

Exhibit A establishes that the features of sending a pattern of bits, monitoring the return pattern and deciding continuity check of claims 4 and 20; the features of a gateway configured to generate a bit pattern and execute a continuity check over a packet network of claim 16 were described in an Invention Disclosure written by the inventor. The Invention Disclosure refers to Technical Manual 76.2100/1, General Description, AN2100 System, Tellabs, Inc. (3/99) ("AN2100 Technical Manual"). The continuity checking features of claims 4, 16 and 20 are disclosed in the inventor's Invention Disclosure. The networking features are shown in the AN2100 Technical Manual at, for example, page 1-1, par. 1.02-1.04 and Figures 1.1 and 2.1.

Claims 4, 16 and 20 recite the additional feature that the continuity test is performed during the set-up of a narrowband call over a packet network. The networking feature is shown

in the AN2100 Technical Manual at, for example, page 1-1, par. 1.02-1.04 and Figures 1.1 and 2.1.

The AN2100 Technical Manual was included as Appendix A to the Provisional Patent Application from which the pending application claims priority.

The dates of both the Invention Disclosure and the AN2100 Technical Manual antedate the effective date of the Q.SCOBB reference (*i.e.*, June 20, 1999). Thus, the subject matter of the pending claims was conceived before the effective date of the Q.SCOBB reference.

The Provisional Patent Application from which the pending application claims priority was filed on August 6, 1999, less than six weeks after the effective date of the Q.SCOBB reference. The enclosed Declaration of Paul A. Levy (Exhibit B) establishes that the applicant diligently pursued filing the Provisional Patent Application based, at least in part, on receipt of the Invention Disclosure. The filing of the Provisional Patent Application constructively reduced the claimed invention to practice.

In view of the foregoing remarks and the enclosed Declarations, applicant respectfully requests withdrawal of the rejections of claims 4, 5, 16 and 20.

Claims 10 and 12 are Patentable Over the Cited References

Claims 10 and 12 were rejected as unpatentable over Howell in view of Nakayama.

Claim 10 has been amended to recite, that "the pattern of bits is generated by a narrowband-to-packet network adapter having a bit pattern generator."

Howell teaches using a tone for a continuity check. Nakayama teaches a bit pattern generator for use in a continuity check. However, neither Howell nor Nakayama teaches or suggests the feature that a narrowband-to-packet network adapter generates a pattern of bits. As shown in FIG. 2, the gateway 100A includes a pattern generator 122. The gateway 100A functions to adapt a narrowband call to a packet network. Page 7, lines 20-21. The arrangement

of the present invention provides for checking the continuity of the adapter as well as the network connection. See page 14, line 23 to page 15, line 9.

Claim 10 is not obvious over the cited references because those references do not teach or suggest each and every element of the claimed invention.

Applicants respectfully request withdrawal of the 35 U.S.C. rejection of claim 10.

Claims 11 and 12 depend from claim 10 and should be allowable for at least the same reasons.

Claims 13-15 are Patentable Over the Cited References

Claims 13, 14, 17 and 18 were rejected as unpatentable over Q.SCOBB in view of Nakayama.

Claim 13 has been amended to recite a gateway "to adapt a narrowband to a packet network." As recited above, the features of the unamended claim 13 were disclosed before the date of the Q.SCOBB reference. The adapting feature of the amended to claim 13 also was disclosed in the AN2100 Technical Manual as described in the AN2100 Technical Manual at, for example, page 1-1, par. 1.02-1.04 and shown in Figures 1.1 and 2.1. Thus, all of the features of amended claim 13 antedate the Q.SCOBB reference. Thus, the Q.SCOBB reference is not prior art to the present invention. Nakayama does not disclose the added feature in question.

Applicants respectfully request withdrawal of the 35 U.S.C. 103 rejection of claim 13 because the Q.SCOBB reference is not a proper prior art reference.

Claims 14 and 15 depend from claim 13 and should be allowable for at least the same reasons.

Conclusion

All pending claims are in condition for allowance.

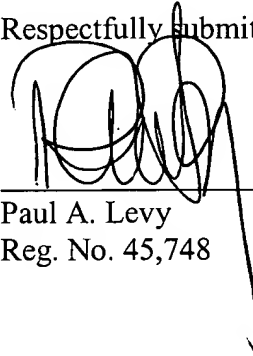
The prior art made of record but not relied upon has not been discussed because none were applied against any of the claims.

Applicant : Scholtens et al.
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Enclosed is a \$172.00 check for excess claims fee and a \$110.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,



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